

Application Serial No: 09/987,766
Attorney Docket No.: 51950 (ACT-163)

REMARKS

Entry of the foregoing, reexamination and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.112, and light of the remarks which follow are respectfully requested.

Claims 1-43 are pending in the application.

By the foregoing amendments, claims 4, 5 and 43 have been canceled without prejudice or disclaimer, and not for reasons of patentability. Claim 1 has been amended by adding language relating to an integrated optic chip. Support can be found at least in Figure 2. Claim 3 has been revised consistent with the amendments to claim 1. Claim 35 has been amended by replacing the term "includes" with "comprising." Claims 44-47 have been newly presented. Support for claims 44 and 45 can be found at least in Figure 2. Support for claim 46 can be found at least in original claim 1, Figure 2, and section [0003] of the application. Support for claim 47 can be found at least in original claim 1 and Figure 2.

Claims 42 and 43 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Notwithstanding the cancellation of claim 43, this rejection is respectfully traversed for at least the following reasons.

The Official Action states that "[t]he word 'monolithic' in new claims 42 and 43 does not appear anywhere in the specification; therefore, the claims lack support" (Official Action at page 2). Applicants respectfully disagree. As described in the MPEP:

The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement. MPEP 2163.02.

An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. (Emphasis added). MPEP 2163(I).

Support for claim 42 can be found at least in Figure 2 (reference numeral 30), while support for canceled claim 43 can be found at least in original claim 1 and Figure 2. The term "monolithic substrate" is well known to persons skilled in this art and means a

Application Serial No: 09/987,766
Attorney Docket No.: 51950 (ACT-163)

substrate formed from a single piece or block of material. Such a substrate is clearly shown in Figure 2. Accordingly, withdrawal of this rejection is respectfully requested.

Claim 1-3, 6, 7, 9-13, 18-23, 35-39 and 41 stand rejected under 35 U.S.C. §102(b) as being anticipated by *Tamura* (Document No. JP 11305151). In addition, claims 8, 14-17 and 40 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Tamura*. These rejections are respectfully traversed for at least the following reasons.

Prior to addressing the rejections, applicants note that a complete translation of *Tamura* has been obtained and attach a copy for the Examiner's reference.

The present invention relates to optical assemblies and to methods for assembling optical assemblies. Based on a complete understanding of the present invention, it is respectfully submitted that the claims cannot properly be rejected based on the teachings of *Tamura*.

Tamura discloses an optical switch. The optical switch includes a substrate 3, a stationary side optical fiber 1, a moving side optical fiber 2, and a graded index optical fiber-type collimator lens 10 as shown in Figures 1 and 3 or a microlens-type collimator lens array 11 as shown in Figure 2.

Tamura does not disclose or suggest each feature of the present invention. For example, *Tamura* does not disclose or suggest an integrated optic chip as set forth, for example, in independent claims 1 and 21. There is simply no motivation, absent applicants' own disclosure, to employ an integrated optic chip in the *Tamura* optical switch.

Regarding claims 35-39, the Examiner takes the position that "the steps described in the claim would be inherent in the structure of the device disclosed by *Tamura*" (Official Action at page 4). Applicants respectfully disagree.

To support an anticipation rejection based on inherency, the Examiner must provide factual and technical grounds establishing that the inherent feature necessarily flows from the teachings of the prior art. See *Ex parte Levy*, 17 USPQ.2d 1461, 1464 (BPAI 1990). The inherency must flow as a necessary result from the prior art, not merely as a possible result. See *In re Oelrich*, 212 USPQ 323, 326 (C.C.P.A. 1981). Given the lack of any factual or technical grounds in the Official Action, the Office has not met its burden in establishing inherency. *Tamura* does not appear to disclose affixing

Application Serial No: 09/987,766
Attorney Docket No.: 51950 (ACT-163)

an optical fiber array to an imaging assembly. Accordingly, the §102(b) rejection with respect to claims 35-39 is improper and should be withdrawn.

For at least the foregoing reasons, withdrawal of the §102(b) and §103(a) rejections based on *Tamura* alone is respectfully requested.

Claims 4, 5 and 24-34 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Tamura* in view of *Shibuya* (U.S. Patent No. 6,340,251). This rejection is respectfully traversed for at least the following reasons.

The Examiner relies on *Shibuya* for that document's alleged disclosure of an integrated optic chip. Specifically, the Examiner points to reference numeral 11 of the *Shibuya* figures in support of this position. As disclosed by *Shibuya*, reference numeral 11 refers to an "end face output type semiconductor laser" (see col. 4, line 5). There is no suggestion whatsoever in *Tamura* or *Shibuya* to use a semiconductor laser in an optical switch such as disclosed by *Tamura*. It is not clear to applicants why or how one would incorporate a laser into the disclosed optical switch without affecting the operability of the disclosed device. Accordingly, withdrawal of the rejection with respect to claims 4, 5 and 24-34 is in order.

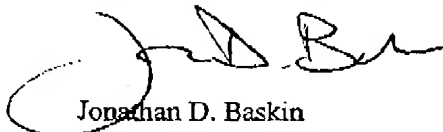
As a final matter, it is noted that the dependent claims are allowable over the applied documents at least for the reasons set forth above with respect to the independent claims. Similarly, newly presented claims 44-47 are believed to patentably distinguish over the applied documents.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited.

Application Serial No: 09/987,766
Attorney Docket No.: 51950 (ACT-163)

If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at his earliest convenience.

Respectfully submitted,



Jonathan D. Baskin
Attorney for Applicant
Registration No. 39,499
Telephone No.: (508) 787-4766
Facsimile No.: (508) 787-4730

c/o EDWARDS & ANGELL, LLP
P.O. Box 9169
Boston, Massachusetts 02209
Date: January 6, 2004